

# Office Action Summary

Application No.  
08/953,477

Applicant(s)  
Kara, Salim G. et al.

Examiner  
Joseph Pokrzywa

Group Art Unit  
2722



☒ Responsive to communication(s) filed on Jul 17, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 57-74 and 90 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 57-74 and 90 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 7/17/00, and has been entered and made of record. Currently, **claims 57 through 74, and 90** are pending.
2. The indicated allowability of **claims 57 through 74, and 90** is withdrawn in view of the newly discovered reference(s) to Kunigami (U.S. Patent Number 5,508,817). Rejections based on the newly cited reference(s) follow.
3. The finality of the Office action dated 3/27/00 is withdrawn in view of the newly discovered reference(s) to Kunigami (U.S. Patent Number 5,508,817).

### ***Response to Arguments***

4. Applicant's arguments with respect to independent **claim 57** have been considered but are moot in view of the new ground(s) of rejection.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 57 through 66, 70 through 74, and 90** are rejected under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent number 5,826,034, cited in the Office action dated 3/27/00) in view of Kunigami (U.S. Patent Number 5,508,817), and further in view of Berkowitz *et al.* (U.S. Patent Number 5,903,877, cited in the Office action dated 3/27/00).

Regarding **claim 57**, Albal discloses a system for delivering information to a selected location (workstations 36 and 46, and fax 44, shown in Fig. 1, and workstation 36, shown in Figs. 5 through 9) from a transmitting location (workstation 30, shown in Fig. 1, and Figs. 5 through 9), wherein the system comprises a transmission station operable at the transmitting location and adapted to transmit the information (column 3, lines 24 through 33) to an intermediate location (payload delivery system 62, being located in various locations, column 6, lines 33 through 48), and an intermediate station operable at the intermediate location (column 6, lines 49 through 60) and adapted to receive the information transmitted (column 6, line 49 through column 7, line 18) by the transmitting means (column 3, lines 31 through 65). Further, the intermediate station comprises a converter circuit (media/protocol converter 88) adapted to electronically receive the

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transmitted information and to convert the transmission to electronic form (column 7, lines 47 through 59), and a reproducing circuit adapted to reproduce the information in human readable form, wherein the reproducing circuit also produces an indicia authorizing delivery of the human readable information to the selected location (column 9, lines 38 through 64, wherein the seal is produced which authorizes delivery).

However, Albal fails to teach of the reproducing circuit producing an indicia of payment authorizing delivery of the human readable information to the selected location. Kunigami discloses a system which delivers information to a selected location (receiver 3, seen in Figs. 1 and 2) from a transmitting location (sender 1, seen in Figs. 1 and 2), wherein an intermediate station (electronic mail center 2, seen in Figs. 1 and 2) comprises a reproducing circuit which produces an indicia of payment authorizing delivery of the human readable information to the selected location (see Fig. 4A, "Fee Payer Identifier" being an "O" or a "D", column 3, line 57 through column 4, line 25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kunigami's teachings in Albal's system, thereby having the reproducing circuit producing an indicia of payment (Fee Payer Identifier) authorizing delivery of the human readable information to the selected location. Albal's system would become more efficient and more automated if modified to incorporate Kunigami's teachings, as the sender or receiver would be responsible for payment, wherein the intermediate station informs the receiver if the payment is performed by the sender.

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Continuing, Albal fails to teach of the converter circuit (media/protocol converter 88) being adapted to electronically receive the transmitted information and to convert the transmission to electronic form if the transmitted information is not initially in electronic form. Berkowitz discloses a system which transmits information through a plurality of devices (column 3, lines 52 through 59) to an intermediate device (transaction request server 20), wherein a converter circuit is adapted to electronically receive the transmitted information and to convert the transmission to electronic form if the transmitted information is not initially in electronic form (column 3, line 67 through column 4, line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Berkowitz's teachings in Albal and Kunigami's system. Albal's system would become more versatile with the addition of Berkowitz's converter circuit, as more user's would be able to send information electronically, wherein the user's do not have electronic mail capabilities or facsimile machines.

Regarding *claim 58*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the intermediate location being selected according to proximity to the selected location (column 3, lines 31 through 49, and column 6, lines 33 through 60).

Regarding *claim 59*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 58, and Albal further teaches of the intermediate location selection is accomplished automatically by the transmitting location through reference to address information with respect to the selected location (column 3, lines 31 through 49, wherein if the sender workstation contains

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the first payload delivery system, seen in column 6, lines 49 through 60, then the second payload delivery system is selected through reference to the destination address).

Regarding *claim 60*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the intermediate location is selected according to proximity to the transmitting location (column 3, lines 31 through 49, and column 6, lines 33 through 60).

Regarding *claim 61*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the converter circuit comprises circuitry adapted to accept electronic documents communicated utilizing different communication protocols (column 7, lines 47 through 59).

Regarding *claim 62*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 61, and Albal further teaches of the different communication protocols include at least two protocols selected from the group consisting of a standardized electronic mail communication protocol (column 8, lines 34 through 37), a special purpose mail communication protocol, a standardized facsimile protocol (column 7, lines 34 through 37), a standardized character based protocol, and a standardized packet based protocol.

Regarding *claim 63*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the converter circuit comprising circuitry adapted to determine delivery address information with respect to the selected location from information

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contained within the transmitted information (column 7, lines 47 through 59, and column 8, lines 28 through 52).

Regarding *claim 64*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 63, and Albal further teaches of the converter circuit comprising circuitry adapted to verify the accuracy of the delivery address information (column 3, lines 31 through 37).

Regarding *claim 65*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of a means for including ancillary information with the transmitted information, wherein the ancillary information being suitable for use by the receiving means in delivery of the transmitted information to the selected location (column 8, lines 28 through 52, and column 9, lines 38 through 47).

Regarding *claim 66*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 65, and Albal further teaches of the ancillary information comprising means for funding delivery of the transmitted information (column 8, line 66 through column 9, line 3).

Regarding *claim 70*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 65, and Albal further teaches of the ancillary information includes a delivery address of the selected location (see Fig. 4, column 8, lines 34 through 52).

Regarding *claim 71*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 70, and Albal further teaches of the converter circuit comprises a means for verifying the accuracy of the delivery address information (column 3, lines 31 through 37).

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Regarding *claim 72*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 65, and Albal further teaches of the ancillary information includes a time of transmission of the document by the transmitting means (column 9, lines 1 through 3), wherein the time being provided by a secure time piece disposed at the transmitting location (wherein a secured time piece would inherently be used by a workstation).

Regarding *claim 73*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 65, and Albal further teaches of the ancillary information includes specific delivery information regarding the delivery of the human readable information, indicating selection of at least one delivery option of a plurality of delivery options available for delivery of the transmitted information (see Fig. 4).

Regarding *claim 74*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the reproducing circuit is operable at least in part with corresponding circuitry disposed at the selected location (column 6, line 33 through column 7, line 59).

Regarding *claim 90*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the intermediate station further comprising an acknowledgment circuit adapted to produce an acknowledgment of receipt of the transmitted information (output manager 84, column 8, lines 24 through 26, and see Figs. 5 through 9, near-end acknowledgment 120, wherein the acknowledgment 120 is produced by a circuit in the near-end server 28).



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7. **Claims 67 through 69** are rejected under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent number 5,826,034, cited in the Office action dated 3/27/00) in view of Kunigami (U.S. Patent Number 5,508,817), further in view of Berkowitz *et al.* (U.S. Patent Number 5,903,877, cited in the Office action dated 3/27/00), and further in view of Maxwell (U.S. Patent Number 5,805,810, cited in the Office action dated 3/27/00).

Regarding *claim 67*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 66, and Albal further teaches of the intermediate station further comprising an acknowledgment circuit adapted to produce an acknowledgment of receipt of the transmitted information (output manager 84, column 8, lines 24 through 26, and see Figs. 5 through 9, near-end acknowledgment 120, wherein the acknowledgment 120 is produced by a circuit in the near-end server 28). However, Albal fails to teach of the acknowledgment circuitry being adapted to transmit the acknowledgment to the transmitting location, wherein the last mentioned portion of the acknowledgment circuit is inactive until the funding means is confirmed. Maxwell discloses a system wherein a way location (netgram workstation 16) converts email messages sent from a first location into postal documents to be sent to a second location (see abstract). Further, Maxwell teaches of transmitting an acknowledgment (exception message or accept message) to the transmitting location, wherein the last mentioned portion of the acknowledgment circuit is inactive until the funding means is confirmed. (column 9, line 27 through column 10, lines 42). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Maxwell's teachings in Albal, Kunigami, and Berkowitz's system,

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thereby including the acknowledgment circuitry being adapted to transmit the acknowledgment to the transmitting location, wherein the last mentioned portion of the acknowledgment circuit is inactive until the funding means is confirmed. Albal's system would become more user friendly with the addition of Maxwell's teachings, as the user of the transmitting station would be informed when the transmission process is complete.

Regarding *claim 68*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 66, but fail to teach if the funding means includes at least a value data packet. Maxwell discloses a system wherein a way location (netgram workstation 16) converts email messages sent from a first location into postal documents to be sent to a second location (see abstract). Further, Maxwell teaches of a funding means which includes at least a value data packet (column 9, lines 19 through 47). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Maxwell's teachings in Albal, Kunigami, and Berkowitz's system. Albal's system would become more efficient with the addition of Maxwell's teachings, as value data would be transmitted to the funding means via a value packet, therein maintaining the transmission operation because the required postage is received.

Regarding *claim 69*, Albal, Kunigami, Berkowitz, and Maxwell disclose the system discussed above in claim 68, and Kunigami discloses a system wherein a value is deducted from a credit stored at the transmitting location (column 7, line 40 through column 8, line 11, and Fig. 11C, wherein Fig. 11C shows a generated report which is sent to the sender 1, showing that the transmission fee is subtracted. Because the generated bill is issued to the sender, it would be

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obvious to a person of ordinary skill in the art that the value of the bill is deducted from a credit stored at the transmitting location, such as a checking account, credit card, credit register, postage meter, etc., all of which are well known in the art). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kunigami's further teachings in the combination system of Albal, Kunigami, Berkowitz, and Maxwell. Albal's system would become more efficient and more automated if modified to incorporate Kunigami's teachings, as the sender or receiver would be responsible for payment, wherein the intermediate station informs the receiver if the payment is performed by the sender.

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*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703) 305-4712. The fax phone number for this Group is (703) 306-5406.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700.

Joseph R. Pokrzywa

August 3, 2000

  
EDWARD L. COLES  
SUPERVISORY PATENT EXAMINER  
GROUP 2700